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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,231	10/31/2000	Leon A. Pintsov	F-224	2617

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EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,231

Applicant(s)

PINTSOV, LEON A.

Examiner

David Q Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5/29/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner's Note

1. Examiner has pointed out particular references contained in the prior art of record in the body of this Action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Status of Claims

2. As requested in Amendment filed on 29 May 2003:

Claims 1-23 were deleted.

Claims 24-32 were added.

Claims 24-32 remain pending.

Drawings

3. The corrected or substitute drawings were received on 29 May 2003. These drawings will be submitted to the Draftsperson for review.

Specification

4. The specification was amended as requested in Amendment filed on 29 May 2003.

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Response to Request for Reconsideration and Arguments

5. The request for consideration and arguments filed on 29 May 2003 under 37 CFR § 1.111 have been considered but are moot in view of the new claims and corresponding new rejections.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 24-27, 29-32** are rejected under 35 U.S.C. 102(a) as being anticipated by **Kara**, PCT Publication WO 99/21330.

As per **claim 24**.

Kara discloses

A method for acknowledging the delivery of a mail piece within a mailing system (Abstract; Summary of the Invention; Fig 1, associated text), the method comprising the steps of:

capturing an electronic image of the mail piece (P27, L7-17);

capturing an image of a recipient's signature when a mail piece is delivered to the recipient (P17, L21-23; P36, L13-16);

capturing a response message composed by the recipient when the mail piece is delivered (P27, L19-21; P37, L19-20); and

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combining the captured electronic image of the mail piece, the captured image of the recipient's signature and the captured response message to form an electronic message response acknowledging receipt of the mail piece (P37, L7-21).

As per **claim 25**.

Kara discloses all the limitations of claim 24.

Kara further discloses (see above citations):

*determining an electronic address of an originator of the mail piece; and
sending the electronic message response to the originator of the mail piece.*

As per **claim 26**.

Kara discloses all the limitations of claim 24.

Kara further discloses (Fig 1-3, associated text; P12, L1-17):

*.. the electronic address of the originator is an e-mail address obtained by
scanning the mail piece.*

As per **claim 27**.

Kara discloses all the limitations of claim 24.

Kara further discloses (Fig 3, associated text; P12, L1-17; P17, L21-23; P36, L13-16):

...capturing the image of the recipient's signature and capturing the response message are performed with an electronic data collection device.

As per **claim 29**.

Kara discloses all the limitations of claim 26.

Kara further discloses (all above citations; Fig 3, associated text):

determining the electronic address of the originator of the mail piece and sending the electronic message response to the originator of the mail piece are performed with the electronic data collection device.

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As per **claim 30**.

Kara discloses all the limitations of claim 26.

Kara further discloses (Fig 3, associated text):

digitally signing the electronic message response; and archiving the signed electronic message response (P9, L12-21; P10, L5-8).

As per **claim 31**.

Kara discloses all the limitations of claim 24.

Kara further discloses (Fig 4-5, associated text):

capturing the response message is optional.

As per **claim 32**.

Kara discloses all the limitations of claim 24.

Kara further discloses (Fig 4-5, associated text):

determining that an originator of the mail piece has requested delivery confirmation.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kara**, PCT Publication WO 99/21330.

Kara discloses all the limitations of claim 24.

Kara does not specifically disclose:

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scanning a printed form containing the recipient's signature and response message to obtain an electronic image of the image of the recipient's signature and the response message.

However Kara teaches that all well-known methods for (1) delivering a message to the intended recipient will be used and (2) evidence of such receipt will be captured, including the recipient's signature, again using well-known methods (P17, L21-23; P27, L19-21; P36, L13-16; P37; L19-20). It is well known in the art that special delivery services typically utilize forms on which the recipient signs, to acknowledge receipt of a message or mailpiece. Therefore it would have been obvious for one ordinarily skilled in the art to have included the use of forms for recipient signatures and have those signatures scanned later for inclusion in the return receipt to the sender. Such a form would simplify the signature capture process and make the system more versatile, thus able to accommodate items such as packages and other, non-document type deliveries.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-8494 for regular communications and 703-746-8494 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL
August 11, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600